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**MAILED**

**AUG 15 2012**

**OFFICE OF PETITIONS**

Lucian Y. Grove, Jr.  
2516 Wycliffe Ave.  
Roanoke VA 24014

In re Patent No. 6,010,468	:	
Issued: January 4, 2000	:	DECISION ON PETITION
Application No. 09/035,136	:	
Filed: March 5, 1998	:	
For: FOOT FLEXION DEVICE	:	

This is a decision on the petition under 37 CFR 1.378(b), filed July 25, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.<sup>1</sup>

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued January 4, 2000. The second maintenance fee could have been paid during the period from January 4, 2007 through July 5, 2007, or with a surcharge during the period from July 6, 2007 through January 4, 2008. Accordingly, this patent expired on January 5, 2008, for failure to timely remit the second maintenance fee.

Petitioner, Lucian Y. Grove, Jr., states that he is the inventor and patentee of the above patent. Petitioner explains that he relied upon Richard Freer to proceed with the filing of the patent application and subsequently entered into an exclusive licensing agreement with his company, Discovery Group, to produce and market the invention. Petitioner asserts that Discovery Group was to "maintain patent maintenance fees" or notify him of their failure to do so. Petitioner

<sup>1</sup> The Office notes that the patent expired for failure to pay **both the second and third maintenance fees**. Petitioner submitted \$1,450.00 for the second maintenance fee and \$700.00 for the surcharge after expiration with the present petition.

avers that Discovery Group did neither. Petitioner indicates that he does not know when the patent formally expired. Petitioner states that he has enclosed the page from the exclusive licensing agreement that stipulates the responsibility of the company. Petitioner maintains that over the past several years, Mr. Freer has not responded to his inquiries or correspondence regarding the invention and that he has no other way to contact Mr. Freer. Petitioner asserts that he did not find Mr. Freer's "LLC to be an active licensed entity with the Virginia SCC (as queried thru the Clerks File System on line)" and that it appears Discovery Group is no longer in business. Petitioner indicates that this licensing agreement has ended and that he desires to reinstate the patent.

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by § 1.20(i)(1) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

The present petition fails to meet requirement (3).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. As stated in Section 711.03(c)(II)(C)(2) of the Manual of Patent Examining Procedure:

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Section 2590(I) of the Manual of Patent Examining Procedure further explains:

As 35 U.S.C. 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. [Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).] That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. [See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm’r Pat. 1988), aff’d sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff’d, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).] See also Final Rule entitled “Final Rules for Patent Maintenance

Fees,” published in the Federal Register at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee’s agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., Inc., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the patent owner is bound by any error that may have been committed by the obligated party. Id.

Petitioner provided a copy of the licensing agreement, effective as of May 20, 1997, between petitioner, Lucian Y. Grove, Jr., M.D., F.A.C.P. (“Licensor”), and Discovery Group, L.C. (“Company” or “Licensee”). Section (d) Patent Expenses states, in pertinent part:

The Company shall be solely responsible for paying all legal expenses, including the filing fees, incurred in applying for, securing, protecting and maintaining patents or other intellectual property protection of the Technology on behalf of Licensor, whether in this or other countries. Company shall have sole discretion as to decision to file or prosecute patent applications, to maintain issued patents and take other measures pursuant to this Section. The Company shall provide Licensor with estimates of major patent prosecution expenses and shall consult with Licensor regarding major prosecution decisions.

In this instance, it appears that Discovery Group was responsible for paying the maintenance fee at the time of the expiration of the patent. Furthermore, as stated in the licensing agreement, Discovery Group had **sole discretion** as to maintaining issued patents. Therefore, petitioner is bound by the delay resulting from the decisions, actions, or inactions of Discovery Group, their

shareholders or members, including those business decisions, actions, or inactions that led to the failure to obtain or remit the maintenance fee. See Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). Moreover, it is immaterial to the delay that led to the expiration that petitioner would not have acquiesced to the actions or inactions of Discovery Group. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989). Any delay caused by Discovery Group, the obligated party at the time the maintenance fee was due, is binding on petitioner. See Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963).

As Discovery Group was obligated to pay the maintenance fee in this patent, petitioner should attempt to locate Mr. Freer or another member of Discovery Group, and send a letter asking Discovery Group to explain the circumstances surrounding its delay in paying the maintenance fees. Specifically, Discovery Group must demonstrate that they knew of the need to pay the maintenance fees and implemented a reliable tracking system to track the maintenance fee due dates. Documentary evidence such as a copy of their tracking system should be submitted. Furthermore, Discovery Group should state if they intentionally allowed the patent to expire. Lastly, Discovery Group should indicate what attempts they made to contact petitioner in a timely manner to allow him to pay the maintenance fees if they had decided not to maintain this patent in force. Petitioner should include a copy of the response to the letter and any supporting documentation with any renewed petition. If no response is received, or if petitioner cannot locate a member of Discovery Group through diligent efforts, petitioner should state such in any renewed petition. The Office reminds petitioner that he was not precluded from paying the maintenance fees at the time they were due. 37 CFR 1.366(a) clearly states:

The patentee may pay maintenance fees and any necessary surcharges, or any person or organization may pay maintenance fees and any necessary surcharges on behalf of a patentee. Authorization by the patentee need not be filed in the Patent and Trademark Office to pay maintenance fees and any necessary surcharges on behalf of the patentee.

In the absence of a statement and documentary evidence from Discovery Group, the obligated party, petitioner is unable to make an adequate showing that the delay in payment of the maintenance fee was unavoidable within the meaning of 35 U.S.C. 41(a) and 37 CFR 1.378(b)(3). The current showing of record is that petitioner did not act in a diligent manner to ensure timely payment of the maintenance fees. Rather, petitioner relied on Discovery Group to pay the maintenance fees. Petitioner did not take reasonable steps to either inquire into the status of the patent and the due dates for the maintenance fee payments (information available to the public through the USPTO website) or to pay the maintenance fees in a timely manner himself.

Accordingly, the petition under 37 CFR 1.378(b) is **dismissed**.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable.

Any request for refund should be in writing to the following address:

Mail Stop 16  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (571) 273-8300  
                                    Attn: Office of Petitions

By hand:                     Customer Services Window  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

Correspondence may also be sent electronically via the EFS-Web System.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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